

Serial No. 09/914,279

REMARKS:

Status of the Claims

Claims 1-12, 14-50, and 55-70 remain pending herein.

Claim 13 has been deleted and its contents have been incorporated into claim 1. Claims 19, 27, 30 and 33 have accordingly been amended to refer to claim 1, rather than claim 13.

Claims 2, 6, 8, 11, 12, 14, 22, 23, 25, 34, 55 and 56 have been amended to include the limitations of the base claim and any intervening claims.

"Use" claims 51-54 have been cancelled.

Method claims 27-33 and 50 are withdrawn. However, these method claims have not been cancelled, as they will be entitled to rejoinder upon allowance of the microemulsion/composition claims from which they depend. See MPEP §821.04: "if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined."

Claim rejection under 35 USC §112, second paragraph

The Office urges that instead of "said oil," claims 2-5 should rather recite "said metabolizable oil."

For claims 3-5, this is reasonable and the proposed change has been made.

Reference is made in claim 2, however, to "oil microdroplets" for which there is adequate antecedent basis.

The Office also suggests changing "said oil" in claim 55 to "said oil microdroplets", which has been done.

Reconsideration and withdrawal of this rejection are requested.

Claim objection under 37 CFR §1.75(c)

Claims 62-70 are objected to as being in improper form because a multiple dependent claim should depend upon other claims only in the alternative. Claim 62 has been amended to obviate this objection.

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Claim rejection under 35 USC §102(b)

Claims 1, 7, 9, 10, 13, 19-21, 64 and 67 are rejected under 35 USC §102(b) as anticipated by Hara et al. (reference # 3). This rejection is respectfully traversed.

Claim 1 has been amended to include the limitations of claim 13, which requires that at least one biologically active macromolecule be adsorbed on the surface of the emulsion. Rather than being adsorbed at the surface of the surface of the emulsion, the biologically active macromolecule of Hara et al. (i.e., plasmid DNA) is incorporated *into* reconstituted chylomicron remnant (RCR) particles. See, e.g., Hara et al. Abstract and discussion throughout, including Fig. 3, in which the DNA is clearly shown at the core of the particle.

For a reference to anticipate a claim it must disclose each and every element of the claim. See MPEP 2131 and cases cited therein, especially, *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), as well as *In re Marshall*, 578 F.2d 301, 304, 198 USPQ 344, 346 (Fed. Cir. 1978). Thus O'Hara fails as an anticipation of claim 1, as well as claims 7, 9, 10, and 19-21 which depend from claim 1.

Claim 13 is deleted and incorporated into claim 1.

Claims 64 and 67 depend from claim 62, which in turn depends from 55-61. Of these, claims 55-58, 60 and 61 are objected to. It appears that claim 59, which depends from claim 55, would also have been objected to, but for the rejection under 35 USC §112, second paragraph, which has been addressed. These claims are now all believed to be in condition for allowance, as they have been amended such that they are no longer dependent upon a rejected base claim.

Reconsideration and withdrawal of the rejection of claims 1, 7, 9, 10, 13, 19-21, 64 and 67 under 35 USC §102(b) are requested.

Claim objections

Claims 6, 8, 11, 12, 14-18, 22-26, 34-49, 55-58, 60 and 61 have been amended such that they are no longer dependent upon a rejected base claim.

It appears that claims 2-5 and 59 would have been objected to as being dependent upon a rejected base claim, but for the rejection under 35 USC §112, second paragraph, which has been addressed above. These claims are now all believed to be in condition for allowance, as they have been amended such that they are no longer dependent upon a rejected base claim.

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It appears that claims 62, 63, 65, 66, 68-70 would have been objected to as merely being dependent upon a rejected base claim, but for the additional claim objection under 37 CFR §1.75(c), which resulted in these claims not being treated further on the merits. This rejection which has been addressed above. These claims are now all believed to be in condition for allowance, as they have been amended such that they are no longer dependent upon a rejected base claim.

CONCLUSION

It is respectfully submitted that all claims are presently in condition for allowance. Should the Examiner be of the view that an interview would expedite consideration of the application, request is made that the Examiner telephone the Applicants' attorney at (703) 433-0510 in order that any outstanding issues be resolved.

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Respectfully submitted,


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